

### **REMARKS**

Upon entry of the present amendment, claims 2-17 will remain pending in the above-identified application and stand ready for further action on the merits. Claim 1 has been canceled, and claims 8-10 and 13-15 have been amended and new claims 16-17 added.

The present amendments to the claims do not introduce new matter into the application as originally filed. For example, the amendments to claims 13 and 15 simply change the dependency of the same claims to claim 2 (based on canceling of claim 1) and change the word "particles" to "particle", since the latter finds explicit support in claim 2 from which they depend.

Regarding the amendments to claims 8-10 and 14, these also find support in the application as originally filed. For example, the amendment to claim 14 finds support at page 26, lines 9-10 of the application, and the amendments to claims 8-10 find support at page 16, line 17 to page 17, line 3 of the specification.

Regarding newly added claims 16-17, the same are based on claims 9-10 but recite more preferred mol % ranges finding support at page 16, line 17 to page 17, line 3 of the specification.

Accordingly, entry of the instant amendment and favorable action on the merits is earnestly solicited at present.

### ***Claim Objections***

Claims 8-10 are objected to under 37 CFR § 1.75(c) as being of improper dependent form. Reconsideration and withdraw of this objection is respectfully requested based on the amendment herein of each of pending claims 8-10.

***Claim Rejections under 35 USC § 112***

Claim 14 is rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

Reconsideration of this rejection is respectfully requested based on the amendment of claim 14 herein to positively recite “applying the conductive coating composition according to claim 13 *by a coating method...*”

***Claim Rejections under 35 USC § 102(b)***

Claims 1-15 are rejected under 35 USC § 102(b) as being anticipated by **JP 03-33185** (JP ‘185).<sup>1</sup>

Reconsideration and withdraw of this rejection is respectfully requested based on the following considerations.

*Legal Standard for Determining Anticipation*

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art.” *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir.

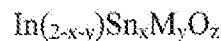
---

<sup>1</sup> The office action indicates that claims 1-18 are being rejection under 35 USC § 102(b), which is in error, since prior to the instant amendment only claims 1-15 were pending in the instant application.

2001) "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Distinctions Over JP 03-33185

JP '185 relates to a fluorescent substance coated with a conductive material having an electric resistance of 1,000  $\Omega$  or less, and the conductive material has a chemical formula:



wherein M is at least one element selected from the group of Sb, Cd, Zn, W, Ti and Mo.

The fluorescent substance is used in a fluorescent display and excited with electron beams having electric charges. Thus, negative charges tend to be accumulated on the fluorescent substance. If the negative charges are not quickly dissipated by grounding, the fluorescent substance carrying the negative charges repels the electron beam and then the fluorescent substance cannot be effectively excited by the electron beam.

To solve such a problem, the invention of JP '185 coats the surface of the fluorescent substance with the conductive material described above to decrease the electric resistance of the substance.

JP '185 only discloses a single-phase oxide containing indium, tin and zinc, whereas the instant invention is concerned with a composite particle made up of zinc oxide and a separate mixed oxide phase containing indium and tin.

Accordingly, the cited JP '185 reference does not disclose any particle of the conductive material represented by the above formula.

Additionally, it is submitted that JP '185 does not suggest that there are any benefits to be gained from producing a particle with two distinct oxide phases (*e.g.*, see pages 45-47 of the instant application, including Table 2 at page 45).

It is also noted that the cited JP '185 reference fails to render the instant invention obvious under the provisions of 35 USC § 103(a), since it fails to provide any teaching, disclosure, reason or rationale that would lead one of ordinary skill in the art to arrive at the present invention as claimed.

As such, it also follows that the instant invention is non-obvious over the same JP '185 reference. Any contentions of the USPTO to the contrary must be reconsidered at present.

### ***Information Disclosure Statement***

Applicants thank the Examiner for the initialed Form PTO SB08 which was submitted with the Information Disclosure Statement filed on April 14, 2006. However, Applicants note that the reference JP-62-7627-A has not been considered by the Examiner due to an alleged lack of a statement of relevancy. Therefore, Applicants note as follows with regard to this reference.

JP-62-7627-A discloses a powder comprising indium oxide and tin oxide. However, it does not disclose composite indium oxide particles comprising zinc oxide and tin-containing indium oxide.

Additionally, regarding the earlier filed IDS, the Examiner is reminded of the provisions of MPEP § 609.04(a) III., which relates to "Content Requirements for an Information

Disclosure Statement” and more particularly to providing a “Concise Explanation of Relevance for Non-English Language Information” and that states as follows:

*...Where the information listed is not in the English language, but was cited in a search report or other action by a foreign patent office in a counterpart foreign application, the requirement for a concise explanation of relevance can be satisfied by submitting an English-language version of the search report or action which indicates the degree of relevance found by the foreign office. This may be an explanation of which portion of the reference is particularly relevant, to which claims it applies, or merely an “X”, “Y”, or “A” indication on a search report.*

Notably in the IDS filed on April 14, 2006 it was positively stated that “Each Japanese patent document submitted herewith is cited in the International Search Report, a copy of which was previously submitted on September 29, 2005.”

Accordingly, submitted herewith is a copy of the Form PTO SB08 which was submitted with the Information Disclosure Statement filed on April 14, 2006.

**The Examiner is respectfully requested to initial the attached Form with regard to JP-62-7627-A and return one (1) copy of the same to the Applicants.**

### **CONCLUSION**

Based upon the amendments and remarks presented herein, the Examiner is respectfully requested to issue a Notice of Allowance clearly indicating that each of pending claims 1-17 are allowed and patentable under the provisions of Title 35 of the United States Code.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John W. Bailey (Reg. No. 32,881) at the telephone number below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Dated: January 22, 2008

Respectfully submitted,

By 

John W. Bailey

Registration No.: 32,881

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Road

Suite 100 East

P.O. Box 747

Falls Church, Virginia 22040-0747

(703) 205-8000

Attorney for Applicant

Enclosure: Copy of the Form PTO SB08 originally submitted with the Information Disclosure Statement filed on April 14, 2006